

REMARKS

Claims 1-10 are pending; claims 1, 5 and 6 have been amended to remove reference symbols from the claims. No new matter has been added. Reconsideration of the application is respectfully requested.

In the Office Action, the Examiner:

- objected to the Abstract
- rejected claims 9 and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite;
- rejected claim 10 under 35 U.S.C. § 101 as directed to non-statutory subject matter;
- rejected claims 1-8 under 35 U.S.C. § 102(a) as anticipated by unpublished U.S. Patent Application 09/212,942 to Hamman.

Objection

The Abstract stands objected to because it is not a single paragraph. A replacement Abstract is attached to this response, and thus applicants request that this objection be withdrawn.

Rejections35 U.S.C. § 112, Second Paragraph

Claims 9 and 10 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the examiner stated that the limitations "a computer program" in claim 9, and "a signal" in claim 10, lack sufficient antecedent basis.

The MPEP notes that claims which take the form: "The product produced by the method of claim 1," or "A method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions ..." are not indefinite under 35 U.S.C. § 112, second paragraph, merely because of the reference to another claim. *See* MPEP § 2173.05(f); *see also* *Ex parte Porter*, 25 U.S.P.Q.2d 1144 (Bd. Pat. App. & Inter. 1992) (finding reference to "the nozzle of claim 7" in a method claim complies with 35 U.S.C. § 112, second paragraph).

Thus, since the format of claims 9 and 10 complies with the requirements of the MPEP § 2173.05(f) and the case law of the Board of Patent Appeals and Interferences, applicants request that the 35 U.S.C. § 112, second paragraph rejections of claims 9 and 10 be withdrawn, and that claims 9 and 10 be allowed.

35 U.S.C. § 101

Claim 10 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 10 has been amended to recite:

“A signal for transporting a computer program, the program comprising instructions for performing the method as claimed in claim 6, wherein said signal is embodied in a processor readable memory.”

Claim 10 now recites the signal in combination with a physical statutory structure, namely the readable memory, and thus a useful, concrete and tangible result is provided. *See In re Lowry*, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Thus, applicants request that the 35 U.S.C. § 101 rejection of claim 10 be withdrawn, and that claim 10 be allowed.

35 U.S.C. § 102(a)

Claims 1-8 are rejected under 35 U.S.C. § 102(a) as anticipated by unpublished U.S. Patent Application 09/212,942 to Hamman (“the unpublished Hamman application.”)

The unpublished Hamman application does not anticipate claims 1-8 because it is does not constitute prior art under 35 U.S.C. § 102(a). Specifically, the unpublished Hamman application was/is not “known or used by others in this country,” as required by 35 U.S.C. § 102(a). The Court of Appeals for the Federal Circuit has interpreted the language “known or used by others in this country” in 35 U.S.C. § 102(a) as meaning knowledge or use which is accessible to the public. *See Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986) *citing In re Bass*, 474 F.2d 1276, 1296, (CCPA 1973) (Baldwin, J., concurring); *see also MPEP*, § 2132.I “Known or Used.”

The unpublished Hamman application clearly does not qualify as prior art under 35 U.S.C. § 102(a), because, contrary to the requirements of the statue, it is *inaccessible* to the

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public. Thus, applicant requests that the 35 U.S.C. § 102(a) rejections of claim 1-8 be withdrawn, and that these claims be allowed.

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Early notification to that effect is respectfully requested.

A fee of \$120.00 for a one-month extension of time in responding to the current office action is believed due. The Commissioner for Patents is hereby authorized to charge this petition fee, as well as any other required fees, to deposit account 50-2061.

Respectfully submitted,



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